

REMARKS

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Claims 1-24 are pending in this application. Claims 1-24 stand rejected under 35 USC § 102 over U.S. Patent No. 5,452,108 (hereinafter Muramatsu). Claims 1, 11, 16, 17, 20 and 21 are currently amended. Claims 6 and 8 are also currently amended. However, these amendments were not made in response to any rejection or objection by the Examiner. For example, minor typographical errors such as removing a misplaced semi-colon, have been corrected. In addition, the amendments to claims 6 and 8 do not narrow claim scope, and may, in some instances, even broaden their scope and, as such, should not result in prosecution history estoppel. No new matter has been presented. Reconsideration of the above-referenced patent application in view of the foregoing amendments and following remarks is respectfully requested.

To establish a *prima facie* case of unpatentability under 35 U.S.C. § 102, the examiner must establish that each and every aspect of the rejected claim is taught by the cited document. With respect to the merits of the specific claim rejections, we begin by discussing claim 1, as currently amended. Regarding claim 1, Muramatsu does not teach each and every element of claim 1. Therefore, it is respectfully asserted that the Examiner has failed to make out a *prima facie* case of unpatentability. Specifically, Muramatsu does not teach "scanning another portion of said paper sheet; and repeating said moving the paper sheet, said scanning, and said moving said scanning head to scan a plurality of portions of said paper sheet," as recited in Assignee's claim 1. More specifically, the portion of Muramatsu cited by the examiner, column 2, lines 58-63, does not even mention a paper sheet, much less moving a paper sheet as recited in Assignee's claim 1. In light of this, it is respectfully requested that the rejection of claim 1 on this basis be withdrawn.

Claims 2-24 distinguish from the cited documents on at least the same and/or a similar basis. It is therefore respectfully requested that the rejection of claims 2-24 be withdrawn as well. It is therefore respectfully requested that claims 1-24 be allowed to proceed to issuance.

The Examiner argues that several aspects of Assignee's claims are inherently taught by Muramatsu. Assignee respectfully disagrees with the Examiner's contention. As is well-settled law, in order to establish inherency, "the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). See also MPEP § 2163.07(a). In the present case, the Examiner has not established any basis for the inherency rejections in the above-referenced office action. The Examiner has not established that the missing descriptive matter is necessarily present in the cited document. The Examiner has also not established that the missing descriptive matter would be recognized by one of ordinary skill. The Federal Circuit has recently stated that to establish inherent anticipation it must be shown that "the disclosure [of the cited document] is sufficient to show that the natural result flowing from the operation as taught [in the cited document] would result in the claimed [subject matter]." *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1343 (Fed. Cir. 2005). The Examiner has failed to show that Muramatsu is sufficient to show that the natural result from the operation of Muramatsu would result in Assignee's claimed subject matter. Accordingly, Assignee respectfully asserts that these rejections have been traversed.

Specifically with regard to the inherency rejection of claim 12, there is nothing in Muramatsu that would teach, inherently or otherwise, "moving said paper sheet further over said scanning window" and further "scanning a third portion of said paper sheet," as recited by Assignee's claim 12. Therefore, Assignee respectfully asserts that this rejection has been traversed.

Although additional arguments are believed to exist for distinguishing the cited documents, the foregoing is believed sufficient to address the Examiner's rejections. Likewise, failure of the Assignee to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of

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the Examiner's position. Instead, it is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is believed not necessary to respond to every position taken by the Examiner with which Assignee does not agree.

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CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Consideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Respectfully submitted,

Dated: _____

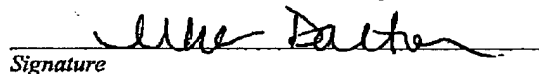
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*I hereby certify that this correspondence is being transmitted by
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